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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,618	11/25/2003	Gregory Scott Riggs	5178-001	7715

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EXAMINER
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DURAND, PAUL R

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/721,618

Applicant(s)

RIGGS, GREGORY SCOTT

Examiner

Paul Durand

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5,11,13-17 and 20-24 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over McGuinness et al (US 5,791,546).

In regard to claims 1 and 17, , McGuinness discloses the invention as claimed including nailing mechanism 14, cap container 44, shuttle mechanism 40, guide slots 24 and 26 and movable linkage 96 and 98 that move in response to the gun being actuated and move the shuttle mechanism 40 (see Figs. 2,3,5,8 and C3,L9 – C4,L63). In the alternative, while McGuinness does not disclose the firing of the tool through the use of a manually actuated means such as hammer, the examiner takes Official Notice that it is old and well known in the art to provide a nailing apparatus that is actuated or fired by manually operated means for the purpose of reducing the complexity of the part.

In regard to claims 2 and 3, McGuinness discloses the invention as claimed including a manually actuated device with portions 4 and 100, which move in relation to each other and cause linkage 96 and 98 to move shuttle 40 between a first and second position (see abstract, Figs. 2,3,5,8 and C3,L9 – C4,L63).

In regard to claims 4 and 5, McGuinness discloses the invention as claimed including a first position where the shuttle mechanism 40 is located under a stack of caps and a second position where the shuttle is located away from the stack of caps to allow a cap to be fed into the shuttle (see Figs. 4-7 and C5,L12-30).

In regard to claim 11, McGuinness discloses the invention as claimed including a seat area in feed slot 34, which hold caps 36 prior to being driven by a nail (see Figs. 7 and 8).

In regard to claims 13,22 and 23, McGuinness discloses the invention as claimed including engaging a surface (no number given) with a driving tool, pressing the driving device causing a portion of the device to move with respect to another portion, driving a cap feeder during the movement and moving a linkage 96 and 98 (see Figs. 2,3,5,8 and C3,L9 – C4,L63). In the alternative, while McGuinness does not disclose the firing of the tool through the use of a manually actuated means such as hammer, the examiner takes Official Notice that it is old and well known in the art to provide a nailing apparatus that is actuated or fired by manually operated means for the purpose of reducing the complexity of the part.

In regard to claims 14,20,21 and 24, McGuinness discloses the invention as claimed including biasing a cap feeder assembly with a spring 6, which allows a shuttle mechanism to move from a first to a second position as the device is moved against a work surface (see Figs. 2,3,5,8 and C3,L9 – C4,L63).

In regard to claim 15 and 24, McGuinness discloses the invention as claimed including linkage 96 and 98 that are connected to first and second portions 4 and 100

where the linkage actuates and causes the feed device in the form of shuttle 40 to actuate (see Figs. 4-7 and C5,L12-30).

In regard to claim 16, McGuinness discloses the invention as claimed including a first position where the shuttle mechanism 40 is located under a stack of caps and a second position where the shuttle is located away from the stack of caps to allow a cap to be fed into the shuttle (see Figs. 4-7 and C5,L12-30).

In regard to claims 25,26 and 30, McGuinness discloses the invention as claimed including a main body portion (generally indicated by 82), movable striker 4, and mechanical linkage 96 where the device is manually actuated by hitting the striker against the surface, triggering the linkage and actuating the feeding device also driving linkage as striker moves up and down (see C5,L11-24). Furthermore, in regard to claim 30 the claim appears to be drawn not to the method, but the structure of the apparatus itself. While structure is allowed in method claims, it must affect the method in a manipulative sense and not amount to the mere claiming of the use of a particular structure. *Ex parte Pfeiffer*, 1962 C.D. 408 (1961).

### ***Claim Rejections - 35 USC § 103***

3. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGuinness et al.

McGuinness discloses the invention substantially as claimed including a seat 34 to hold caps 36 prior to being driven into a work piece (see Figs. 7 and 8). What McGuinness does not disclose is the seat being tapered. However, the examiner takes

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Official Notice that it is old and well known in the art to provide a tapered edge on a guide for a driven member for the purpose of ensuring that the member is correctly driven into the work piece. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the driving device of McGuinness with a tapered seat edge for the purpose of ensuring that the member is correctly driven into the work piece.

4. Claims 6,10,18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuinness et al in view of Omli (US 5,947,362) and in further view of Lombard (US 593,065).

In regard to claims 6,10,18 and 19, McGuinness discloses the invention substantially as claimed except for the feeding device arranged on an inclination and a curved feed track. However, Omli teaches that it is old and well known in the art of tool driving to have a feed mechanism comprised of feed lever 64, that is arranged at an angle for the purpose of efficiently feeding a plurality of caps (see Figs. 5-7 and C8,L21-34). Furthermore, Lombard teaches that it is old and well known in the art of tool driving to have a guide 26, which is curved from a container 2 to a bottom of an ejection area 14 for the further purpose of efficiently feeding a plurality of members (see Figs.1,4 and Pg.2, L71-115). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the driving device of McGuinness with the feed means as taught by Omli and the guide means as taught by Lombard for the purpose of efficiently feeding a plurality of members.

In regard to claims 7-9, McGuinness discloses the invention substantially as claimed including spring 6, links 96 and 98, which are connected to shuttle device 40 when actuated and cause the shuttle member to move (see Figs. 2,3,5,8 and C3,L9 – C4,L63).

***Allowable Subject Matter***

5. Claims 27-29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

6. From, the phone interview on 12/9/2004, the examiner is made aware that the inventor is a small inventor, who has increased his efficiency in his duties by utilizing the present invention.

7. Applicant's arguments filed 11/8/2004 have been fully considered but they are not persuasive.

8. In regard to the claims, applicant argues that the fashion of operation of applicant's invention differs from that of the primary reference of McGuinness. Applicant bases this argument on the fact that invention actuates a feed mechanism and drives a staple and a cap from the feed mechanism into the work piece. While the examiner does not disagree with the applicant's argument on the mode of operation, the examiner asserts that the applicant is arguing features that are not claimed. Although

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the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, given the broadest reasonable interpretation of the claims, there appears to be a discrepancy between the actuation of the stapler and the feed mechanism. The examiner asserts that the claims as recited appear more to the actuation of a feed mechanism than they do toward the movement of a feed mechanism and a staple device simultaneous, as the examiner understands the applicant's novelty. In claim 1 for example, a manually actuated staple gun does not necessarily need to be manually driven by a hand or hammer. The examiner asserts that the use of a trigger for a tool which is powered pneumatically or electrically can fall under a reasonable recitation of the claim as all it requires is some sort of manual movement to drive the staple. Still furthermore, from the interpretation of the claims the operation of the gun and of the feed mechanism does not need to occur from the same actuation means and can occur from different mechanisms, which is the interpretation for the rejection above. Applicant is requested to consider some sort of limitation that incorporates the simultaneous operation of the feed mechanism and the driving of the staple as the striker plate is engaged against the work piece.

Therefore, for the reasons indicated above, the rejection is deemed proper.



***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Durand whose telephone number is 571-272-4459. The examiner can normally be reached on 0730-1800, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Durand  
January 19, 2005



Rinaldi I. Rada  
Supervisory Patent Examiner  
Group 3700